

Remarks

This Amendment is in response to the Office Action dated **February 6, 2004**. In the Office Action claim 38 was rejected under 35 USC 112, first paragraph. Claims 3 and 38 were rejected under 35 USC 112, second paragraph. Claim 1-3, 5-7, 36 and 38 were rejected under 35 USC 102(b) as being anticipated by Vonesh et al (WO 00/33770). Claims 8, 9, and 37 were rejected under 35 USC 103(a) as being unpatentable over Vonesh et al. Claim 38 was rejected under 35 USC 102(e) as being anticipated by Vrba (6,168,321). These rejections will be addressed under headings consistent with the basis of the rejection.

35 USC 112

In the Office Action claim 38 was rejected under 35 USC 112, first paragraph. The Office Action asserts that there is no basis for the limitation that the self-expanding cells are capable of self-expansion independently of the balloon expandable cells (i.e that the self-expanding cells expand independently of the balloon expandable cells).

Claim 38 has been amended to recite that the self-expanding cells are capable of self expansion without expansion of the balloon expandable cells. Applicant asserts that it was well-known by one skilled in the art at the time of the invention that, unless restricted, self expanding cells expand independently of adjacent balloon expandable cells. It is the nature of self expanding material to expand when exposed to a critical temperature. For certain self-expanding materials this critical temperature is reached within the body of most mammals. As such, self-expanding cells may expand without the expansion of the balloon expandable cells which require an interior force. Applicant respectfully requests that this 35 USC 112 rejection of claim 38 be withdrawn.

In the Office Action claims 3 and 38 were rejected under 35 USC 112, second paragraph. The Office Action asserts that claim 3 contradicts claim 2. Applicant disagrees. It is possible for a stent to have first, second and third balloon expandable segments, and a self-expanding segment, where the self-expanding is between the first and second balloon expandable segments and between the second and third balloon expandable segments. An example of such a configuration is shown schematically below where the balloon expandable segments are designated by the abbreviation BE and the self-expanding segments are designated

by the abbreviation SE.

1stBE 1stSE 3rdBE 2ndSE 2ndBE

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In claim 38, the word "independently" is said not to be clear. Claim 38 has been amended to recite that the self-expanding cells are capable of self expansion without expansion of the balloon expandable cells. The "independently" language has been removed in order to make claim 38 more clear.

Applicant respectfully requests that the rejection of claims 3 and 38 under 35 USC 112, second paragraph be withdrawn.

35 USC 102(b)

In the Office Action, claim 1-3, 5-7, 36 and 38 were rejected under 35 USC 102(b) as being anticipated by Vonesh et al (WO 00/33770). The Office Action points to figure 9 as disclosing balloon expandable segments and self-expanding segments. Applicant points out that page 16, line 35 through page 17, line 2 of Vonesh wherein FIGS 6-9 describes the balloon expandable segments as actually self-expanding and balloon distensible. As such, Vonesh does not teach the express limitation of independent claims 1, 5, and 38 which recite a balloon expandable segment which is not self-expanding. Thus, Applicant believes the 102(b) rejection of independent claims 1, 5, and 38 is inappropriate and that these claims are allowable. Furthermore, Applicant believes dependent claims 2-3, 6-7, and 36 are allowable for at least the reason that they claim dependence on allowable base claims. Applicant respectfully requests that the 102(b) anticipation rejection of claims 1-3, 5-7, 36 and 38 be withdrawn.

35 USC 103(a)

In the Office Action claims 8, 9, and 37 were rejected under 35 USC 103(a) as being unpatentable over Vonesh et al. The Office Action asserts that it would have been obvious to lengthen the balloon expandable sections in the figure 9 embodiment. Applicant respectfully

disagrees. Applicant believes that independent claims 1 and 5 are allowable and that for at least this reason, claims 8, 9, and 37 are allowable. As discussed above, Vonesh does not teach or suggest the limitations of independent claims 1 and 5 and dependent claim 8 of a stent having cells that are balloon expandable but non-self-expanding, nor is this obvious in light of the teaching of Vonesh. Vonesh teaches a self-expanding stent wrapped in a balloon expandable tube or tube portions. Thus, the only portions which have balloon expandable characteristics also have self-expanding characteristics. The concept taught in Vonesh is that of assembling layers of material in order to affect portions of a self-expanding stent such that they behave as portions having both self-expanding and balloon distensible characteristics. This teaching does not make obvious the teachings of the instant claims which recite stents having self-expanding portions which are not balloon expandable.

In addition, Vonesh does not teach nor suggest islands containing more than one self-expanding cell as recited in claim 9.

Furthermore, Vonesh does not teach nor suggest at least 50% of the stent being made from one piece of balloon expandable metal as recited in claim 37. Vonesh teaches the use of balloon expandable polymeric material. A metallic balloon expandable stent portion is not taught or suggested.

For at least the above reasons, Applicant respectfully requests the 35 USC 103(a) rejection of claims 8, 9, and 37 as being unpatentable over Vonesh et al be withdrawn.

35 USC 102(e)

In the Office Action, claim 38 was rejected under 35 USC 102(e) as being anticipated by Vrba (6,168,321). Applicant has amended claim 38 such that it recites that the stent has a distal-most end and a proximal-most end, each end constructed of balloon expandable material. Vrba does not teach this limitation.

Applicant respectfully requests that the 35 USC 102(e) rejection of claim 38 be withdrawn.

CONCLUSION

In view of the foregoing, it is believed that the present application, with claims 1-3, 5-9, and 36-38, is in condition for allowance. Early action to that effect is earnestly solicited.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: May 5, 2004

By: Brendan Babcock
Brendan C. Babcock
Registration No.: 50705

6109 Blue Circle Drive, Suite 2000
Minnetonka, MN 55343-9185
Telephone: (952) 563-3000
Facsimile: (952) 563-3001
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